

Application No.: 09/316,430
Amendment dated: November 20, 2003
Reply to Office Action of: May 22, 2003

REMARKS

This amendment is responsive to the Office Action dated May 22, 2003.

Claims in this case are 17-52, which are presented for consideration in the light of the following considerations.

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*** Note that unless stated otherwise, all references to Applicant's specification are made to the substitute specification filed 3/4/03, with marked paragraphs.**

I. Background Statement

The present application was originally submitted in view of interfering subject matter with the claims of U.S. Patent No. 5,758,328 (Giovannoli, '328 patent). The '328 patent illustrates a "central office" solely as a single block in Figure 4. In view of the

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limited disclosure in the '328 patent, the structure of the "central office" is vague and must be implied from the general descriptions and the flow diagrams in the patent.

As described in the patent, overall, the function of the "central office" is to route a "specified class of vendors" (col. 7, line 5) by "filtering," which "may simply involve limiting the network members" (col. 5, line 22) given communication as directed.

Predominantly filtering involves merchandise, e.g. vendor's product (col. 5, line 44) e.g., specified merchandise as "volt meters" (col. 7, line 11). Repeated reference in the patent is made to "buyers" and "vendors" (e.g., col. 2, lines 66-67).

From the outset it is clear that the overall function of Applicant's system coincides to that of the '328 patent as stated above. Specifically, Applicant's system serves "to direct and exchange communication traffic, for example, in the form of offers and responses, between selective members of plural groups or sub-groups, such as vendors or buyer...." (page 6, lines 9-12). However, language differences do exist and have become primary issues. Essentially, the major issues in the case involve the terminology and such operations as "filtering" or "selecting" as related to the selection of a vendor for example. Fundamentally, the "selection" or "filtering" operations of the two systems are clearly the same as explained in detail below. Also, vendor selections are similar. Note that the '328 patent repeatedly uses the term "selecting" to indicate the "filtering" operations that re described (see claim 1, line 43; claim 3, line 61; etc.).

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II. Preliminary Comment

A. The Term " Filter Means" Is Supported By Applicant

The Office Action, dated 5/22/2003 (OA herein), challenges Applicant's remarks which are asserted to indicate that 35 U.S.C. § 112, ¶ 6 is not applicable (OA pages 6-8). In fact, the last amendment herein dated 3/4/03, pursued both alternatives, i.e. interpretation possibilities with § 112, ¶ 6 being either applicable or inapplicable, that is, in reference to the "filter means" term.

Specifically, as stated in the amendment: "a strong basis exists for contending that the 'filter means' element is not subject to interpretation under § 112, ¶ 6" (amendment page 5, mid-page); however, on the next page, the amendment states: "a possibility exists that the claim element 'filter means' might be urged for interpretation in accordance with 35 USC § 112, ¶ 6" (amendment page 6, mid-page). Accordingly, it may be seen that the element was treated under either interpretation.

In any event, the means-plus-function limitation is treated at length below.

B. Vendor Selections Are Similar In The Two Systems

1. As stated, the system of the '328 patent attains a connection by "filtering" which may involve various criteria, e.g., goods desired (col. 5, line 44; col. 7, line 19). Similarly, Applicant's system attains communication selectively based on the same criteria, e.g., merchandise or goods (page 12, line 25). Other similar selection or filtering criteria is disclosed in each of the two specifications.

2. A somewhat related issue involves the possible distinction between the terms "selection" and "filtering." In fact, the two functions are the same, i.e., selection of

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a vendor or vendors based on specific criteria which criteria may include the desired merchandise. As mentioned above, the '328 patent uses both words in a similar meaning context.

3. Further with regard to distinctions of terminology, the newly presented claims 35-52 are submitted with the exact terminology of Applicant's specification and with clear and explicit meaning. The related claims are indicated in the following chart:

Related Claims

'328 Patent	Applicant's Claims 17-34	Applicant's Claims 35-52
1	17	35
2	18	36
3	19	37
4	20	38
5	21	39
6	22	40
7	23	41
8	24	42
9	25	43
10	26	44
11	27	45
12	28	46
13	29	47
15	30	48
16	31	49
17	32	50
18	33	51
19	34	52

Considering the claims 35-52 the term "selection" encompasses routing selectively to a particular vendor or group of vendors in accordance with specific criteria.

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The selection operation is disclosed in detail in Applicant's specification. Note the use of the term in claims 1 and 3, for example, in the '328 patent. The routing for a selection maybe obtained selectively by merchandise codes (specification page 37) or by the qualification of members in accordance with various criteria as identification, registration etc (specification page 39, lines 28-34).

Other explicit terms also have been adopted in claims 35-52 e.g., "traffic control system" (Figures 1 and 2). In that manner, the rejections based on new matter and non-disclosure are deemed to be overcome with respect to these claim terms.

As a somewhat related comment here, it is to be noted that the use of ANI or DNIS signals for identification, does not preclude the clear teaching of merchandise as a major criteria for vendor selection. In that regard, note that the '328 patent mentions member registration (col. 5, line 3) and also mention is made of obtaining buyer and seller data (see flow diagrams, Figure 5; also Figure 7). ANI and DNIS simply provide short cuts for obtaining such data.

III. Objections To Prior Amendments On The Basis Of "New Matter" Are Inappropriate

It is noted that page 5 of the OA (5/22/2003) indicates a requirement of Applicant "to cancel the new matter in the reply to this Office Action." However as the "requirement" is not final, it would appear expedient to leave the matter uncanceled with the request for reconsideration provided hereby.

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(i) **PROPOSED DRAWING CHANGE, Figure 2** recommendation requested.

Objection is made to the requested drawing change in the block "TS" from "DIAL-UP PUBLIC TELEPHONE SYSTEM" to "COMMUNICATION SYSTEM/DIAL-UP PUBLIC TELEPHONE SYSTEM," on the basis that the change is unduly broadening. Specifically, concern was mentioned with respect to such communication systems as "internet telephone," "wireless," etc. Respectfully, such forms of communication are explicitly set forth in Applicant's specification.

The objective of the proposed drawing modification is to indicate a functional COMMUNICATION SYSTEM that maybe embodied as a DIAL-UP PUBLIC TELEPHONE SYSTEM. Specifically, Applicant's specification indicates the use of "personal computers" thereby indicating internet telephone operations (see page 6, line 28). More specifically, at page 8, beginning on line 15, several communication systems alternatives are referred to, again, including "desktop PCs" (personal computers). Additionally, "electronic bulletin boards", on-line computer services and other communication systems are mentioned.

With regard to "wireless" communication systems, at page 15, line 28, specific reference is made to a "cellular telephone." Still, another form of a communication system is indicated at page 31, line 6, by a reference to a "private network." Still further, the text at page 34, lines 34-35, recognizes the possibility "for a wide variety of communications to the dial-up telephone system TS."

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In view of the above specific disclosures of various communications systems, it is respectfully submitted that an adequate disclosure clearly exists for a cosmetic change tagging the system TS generically as a "communication system," while indicating the exemplary embodiment as a "dial-up telephone system."

- (ii) **PROPOSED PRIOR AMENDMENT, page 6, line 13;** reconsideration requested.

NOTE: References to the specification in this section are from the prior amendment and outline Roman numerals, e.g. "(ii)" coincide to those in the Office Action.

In Applicant's disclosed system, merchandise classifications and their attendant processing accomplish several functions, including controlling and regulating select communications between vendor and buyer terminals on the basis of merchandise (page 37, lines 25-26; page 45, line 8). Such operations also include:

- (1) Qualification (page 32, line 13; page 41, line 33):

In view of the specific disclosures indicated above, a proposed cosmetic amendment at page 6 is intended merely as an alerting comment to the multiple criterion of "selective routing." The language is submitted to be fully appropriate to the disclosure and reconsideration is respectfully requested.

- (iii) **PROPOSED PRIOR AMENDMENT, page 11, line 3 (7-8)** reconsideration requested.

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The objective of the proposed cosmetic amendment is with respect to the system depicted in Figure 5 and specifically, the "TRAFFIC CONTROL" system which appears broadly in Figure 2. In that regard, the traffic control system as labeled does not include the word "central," Consequently, it was deemed appropriate to delete the word "central" from the text in line 3. Furthermore, the total system of Figure 2 accomplishes far more than "scheduling and routing" (page 11, line 8). Specifically, the total system of Figure 2 involves alternative communication facilities (format switch), selectively, data storage, operator alternative, and on and on. Consequently, it is deemed appropriate and proper to delete the terms "scheduling and routing,"

Finally, with regard to page 11, line 7, the addition of the words "a form of" is appropriate in relation to the other changes indicated above. Clearly, it is understood that any disclosed embodiment is "a form of" an illustrative system. Again, reconsideration is respectfully requested.

- (iv) **PROPOSED PRIOR AMENDMENT, page 19, line 2,** reconsideration requested.

The OA states: "The disclosure does not show that TIS carries out filtering of vendors...".

Figure 2 discloses the broad system TIS. Figure 5 is in more detailed block diagram of the traffic control system of Figure 2, i.e. TIS (page 11, line 3). Figure 6 is a flow diagram illustrating an operation of the system that Figure 5, i.e. TIS (page 11, line 6).

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The qualification unit T28 (Figure 5) functions to limit buyers and vendors (page 37, line 3). Accordingly, the cosmetic change requested at page 19, being consistent with the disclosure, is submitted simply for that purpose and reconsideration is respectfully requested.

- (v) **PROPOSED PRIOR AMENDMENT, page 24, lines 7 and 8**, reconsideration requested.

Similar cosmetic changes requested regarding the term "filtering" were treated above and on that basis are deemed appropriate. Accordingly reconsideration is respectfully requested.

- (vi) **PROPOSED PRIOR AMENDMENT, page 33, line 4** reconsideration requested.

The cosmetic change of the term "and" is, again, sought for the purpose of indicating the system functions of using merchandise codes to both select routing and to avoid information overload. Perhaps Applicant's attorney is confused; however, the system clearly discloses the function of selectivity and in that regard the attendant additional function of combating overload. The cosmetic change requested is submitted to be clearly in accord. Of course, the selectivity logic, as treated above, also involves the operation of qualification. The quoted specification language in the OA does not seem to be inconsistent with the requested cosmetic changes. Similar comments are applicable to the operation of the cosmetic change entered on page 37, line 9.

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**(vii and viii) PROPOSED PRIOR AMENDMENT, page 41, line 10 and page 45,
line 2 reconsideration requested.**

The extensive treatment of selection as indicated above relating to merchandise are a criteria for vendor selection supported request. The specification emphatically supports the request by operation of the selection structure.

A. The Rejection Under 35 USC § 112 is Improper

Respectfully, the operation of "filtering" as executed by the system of the '328 patent functionally coincides to Applicant's operation of "selecting." In each case, operations are executed to communicate with a seller in accordance with pre-established conditions. In the system of the '328 patent, the major "pre-established conditions" relates to the goods desired (col. 5, line 44; col. 7, line 11). Similarly, in Applicant's system, a major "pre-established condition" involves the goods or merchandise desired (page 12, lines 25, 30; page 37, lines 15-17).

Another criteria of the '328 patent (a "pre-established condition") involves the member class (col. 6, line 57; col. 7, line 2). Similarly, in Applicant's system, the class of the vendor is a criteria of selection (page 38, line 23).

The '328 patent discloses several other criteria or bases for selection which are defined by "pre-established conditions." Specifically, mention is made of location (col. 7, line 11); nature of transaction, col. 7, line 19; distance, col. 7, line 24; likelihood of

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action, col. 8, line 15; persons, col. 6, line 63, 65; and so on. Mentions are also made of "limiting" (col. 5, lines 21-23) and routing to a specified class (col. 7, line 4).

Similarly, Applicant's system is described to involve additional criteria, member identification (page 39, line 31); special information (page 41, line 32); select groups (page 44, line 25); and so on. Of course, qualification is widely mentioned.

The two-systems function to accomplish identical operations of "filtering" or "selecting," as used to establish communication from a buyer to a selected vendor. In the '328 patent, the detail of the structure is limited to a block in Figure 4 simply labeled "central office." The structure for Applicant's system for accomplishing the functions is shown in far greater detail; however, the alternative possibilities accommodated by Applicant's structure certainly cannot deter from the basic functional disclosure. Clearly, the present system supports the claims as presented either by use of the term "filtering" or the alternative term "selecting," which in the present context have similar meanings.

The OA asserts that Applicant's system does not enable a buyer to select criteria which accomplishes a connection with a particular vendor, contending the selection is made as part of the request. Applicant's attorney does not understand such a position.

Clearly, the extensive treatment of merchandise codes (page 37) and the selectivity operations expressly indicate the criteria of pre-established conditions which accomplish selective communication (see page 1, line 25; page 5, line 18; page 6, line 9; page 8, line 12; page 12, line 21; page 15, line 15; page 24, lines 6, 11; page 33, line 12; page 37, line 18; page 38, lines 20, 27). Further, with regard to routing see page 7, line 4, 16, 25, 31; and page 18, line 12.

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In the Office Action, reference is made to page 9 of the last amendment; however, the passage clearly indicates that the selections are made "in accordance with the merchandise codes." Accordingly, the selection is made precisely in accordance with the "goods" criteria of '328 patent.

Also, reference is made in the OA to Applicant's specification at page 23, wherein a direct connection is described. Such operation is clearly an alternative. Note that the '328 patent also discloses alternative communication (col. 5, line 48). Examples of alternative operations are certainly not exclusive of other operating modes.

Also, reference is made to page 41 of the specification and the comment regarding merchandise codes. Clearly, Applicant's system of merchandise codes is an explicit description of the manner in which communication may be selectively accomplished on the basis of "goods," just as described broadly in the '328 patent. Essentially, the '328 patent does not explain the detail of accomplishing communication based on the nature of the "goods" (col. 5, line 44; col. 7, line 11), but rather leaves the matter undisclosed. On the contrary, Applicant discloses a system of merchandise codes whereby processing is accomplished to perform the selection or filter operation.

Reference is also made to the operation in Applicant's system with the attendant operation "to prevent information overload" (page 24, line 8). It is understood that any selectivity or filtering which expedites a desired connection from a multitude of possibilities has the effect of preventing information overload. The mere statement of that advantage clearly is not a limiting consideration.

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In view of the clear and explicit selectivity described in the present specification which functionally coincides to the filtering of the '328 patent, reconsideration is respectfully requested.

B. The Rejections Under 35 USC § 102 And 103 Are Improper.

These considerations are based upon ignoring limitations in the claims which are supported as indicated at length above. Consequently, the rejections are not well founded. Specifically, the claims now presented are cast in terms of "filtering" operations or "selecting" operations. Reconsideration accordingly is respectfully requested on the basis of such limitations.

In spite of the supported language of the present claims, a few comments with respect to the cited art is deemed appropriate. The Spiegelhoff, et al. patent (U.S. Patent No. 5,742,931) is directed to an information system for interrogating warehouses and is distinguished by the claims herein. Similarly, the Shavit, et al. patent (U.S. Patent No. 4,799,156) also involves addressing which does not meet the limitations as set forth in the present claims. The Maloney, et al. patent (U.S. Patent No. 5,684,870) discloses only part of the selectivity and accordingly is distinct. Applicant urges the substance of the claims as presented in total which substance is fully supported in the specification and on that basis, the claims are distinct.

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IV. CONCLUSION

Review of the above detailed considerations and reconsideration is respectfully requested with regard to acceptance of the specification amendments and recognition of the support for the substance in each of the claims. Examiner's detailed OA is appreciated and reconsideration is respectfully requested with a view toward allowance.

Favorable consideration and allowance of the claims pending here is respectfully requested.

Respectfully submitted,

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